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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,925	01/23/2001	Kaius Kiiren Polikarpus	DP-300566	1447

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EXAMINER

OLSEN, KAJ K

ART UNIT

PAPER NUMBER

1753

DATE MAILED: 06/24/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application N .

09/767,925

Applicant(s)

POLIKARPUS ET AL.

Examiner

Kaj Olsen

Art Unit

1753

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached discussion.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-32, 36, 37.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 6-11-2003 have been fully considered but they are not persuasive. Applicant urges that the examiner has failed to establish a *prima facie* case for obviousness for a number of reasons. In particular, applicant appears to be urging that neither Sugiyama nor Friese individually teach the claimed invention. The examiner would agree that neither Sugiyama nor Friese anticipate the claimed invention, but the rejection is based on obviousness of the combination of the two references.
2. Applicant also urges that the examiner has failed to show motivation for the *prima facie* case of obviousness. This point appears to ignore the paragraph bridging col. 2 and 3 of Friese which provides clear motivation for the use of the teaching of Friese for the sensor of Sugiyama.
3. Applicant also urges that the examiner has not considered either the references or the applicant's invention as a whole. In particular, applicant urges that there is no suggestion in Sugiyama that mixing alumina with the zirconia would not adversely affect the M/C ratio, the sintered grain size, or any other desired properties. First, it appears the applicant is attempting to cast doubt on the examiner's combination of references without asserting (and/or providing any evidence) that the applicant believes these various properties would be affected in an unexpected manner. If the applicant wishes to provide an appropriate declaration or affidavit establishing that these various properties were affected in an unexpected manner when the applicant added alumina to the electrolyte at the time of the present invention, then the applicant is invited to do so. It is the examiner's opinion that the rejections of record appropriately established a *prima facie* case of obviousness and it is the applicant's responsibility to thereby shift the burden of

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proof back to the Office. However, it is not persuasive to merely allege that the examiner has not considered all the possible complications with adding alumina to an electrolyte, without providing some evidence that these properties would be affected or even whether those possible complications are outside the purview of one possessing ordinary skill in the art.

4. Second, it is unclear to the examiner why the applicant believes these features would be adversely affected by the addition of alumina to the electrolyte. With respect to the M/C ratio, Friese gives no indication that the alumina had any effect of the crystalline forms of zirconia present in the electrolyte because Friese appears to have cubic zirconia irrespective of the alumina content of the electrolyte (col. 1, line 63 through col. 2, line 34 and the first table of col. 9). If alumina doesn't affect the cubic phase, it is unclear (absent appropriate evidence to the contrary) that alumina would affect the monoclinic concentration to such an extent, if at all, that the final concentration of monoclinic as set forth by Sugiyama would then fall outside the broad claimed range of monoclinic set forth by the present invention. With respect to the grain size, Friese was already aware of the effect that alumina has on grain sizes. In particular, it appears that a number of concentrations of alumina have little effect on the final grain sizes (i.e. Friese starting with grain sizes of less than a micron and ended up with grain sizes that were about a micron or less (see example 2 in col. 6 and the first table of col. 9). With respect to the vaguely suggested "any other of the desired properties", the examiner cannot appropriately respond to this argument absent any specific property the applicant believes the examiner has ignored.

5. With respect to the rejections of the other claims with the use of Wang, Kojima, Lankheet or Aizawa, the examiner responded to these arguments in paragraph 28 of the final rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaj Olsen whose telephone number is (703) 305-0506. The examiner can normally be reached on Monday through Thursday from 7:00 AM-4:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Nam Nguyen, can be reached at (703) 308-3322.

When filing a fax in Group 1700, please indicate in the header "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of this application. This will expedite processing of your papers. The fax number for regular communications is (703) 305-3599 and the fax number for after-final communications is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-0661.



Kaj K. Olsen
Patent Examiner
AU 1753
June 23, 2003